

REMARKS

Claims 1-47, as amended by Applicants' May 17, 2004 Amendment and Response to Office Action, are currently pending in the present application. No claims have been canceled or further amended in this Response. Reconsideration of the above-identified patent application is hereby requested in view of the following Remarks and the supporting Declaration enclosed herewith.

REJECTIONS UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1-7, 11-18, 22, 23, 25-27, 29, 30, 32-34, 36, 37, 39-41, 43, 44, 46 and 47 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,252,883, issued to Schweickart et al. ("Schweickart"), in view of Uchida et al. WO 00/68913 (priority document of U.S. Patent 6,696,956) ("Uchida"). Reconsideration and withdrawal of this rejection is requested in view of the Declaration of Matthew D. Durell, Esq. enclosed herewith and the following discussion.

With regard to claims 1-7, 11-18, 22, 23, 25-27, 29, 30, 32-34, 36, 37, 39-41, 43, 44, 46 and 47, the Examiner acknowledges that the declarations of co-inventor Deane Gardner and Marina Portnova, Esq. submitted with Applicants' September 19, 2005 Request for Continued Examination ("RCE") constitute "sufficient [evidence] to establish a conception of the invention prior to the effective date of the Uchida reference. October 5, 2005 Action, Page 2, para. 4. However, the Examiner has re-asserted the § 103 rejection of the above-referenced claims, stating, "[t]he declaration [under 37 C.F.R. § 1.131] is defective since all inventors did not sign the declaration." October 5, 2005 Action, Page 2, para. 3. Applicants respectfully traverse.

The Examiner correctly notes that "[a]ffidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 C.F.R. § 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). October 5, 2005 Action, Page 2, para. 3 (citing in re Carlson, 79 F. 2d 900, 27 USPQ 400 (CCPA 1935) (emphasis in original)). However, "where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient." MPEP § 715.04. As shown herein, co-inventor Mitz Kurobe has refused to sign or otherwise cooperate in the preparation and execution of a declaration of prior invention under 37 C.F.R. § 1.131. As such, Applicants respectfully submit that the declaration of Deane Gardner, co-inventor of all claims now pending in this application, is sufficient to overcome the Uchida reference.

Mitz Kurobe was first contacted by email in June 2005 for purposes of obtaining a declaration under 37 C.F.R. § 1.131. Declaration of Matthew D. Durell, Esq. at ¶ 3 (hereinafter "Durell Declaration"). At that time, Mitz Kurobe was asked to provide alternate contact information. *Id.* On June 16, 2005, Mitz Kurobe replied by email to advise that he now resides in Tokyo, Japan. *Id.* at ¶ 4. No alternate contact information was provided. *Id.*

On June 16, 2005, copies of the present application, as well as other file wrapper materials were forwarded to Mitz Kurobe via email so that Mitz Kurobe could review the relevant information prior to signing the declaration. *Id.* at ¶ 5. At that time, counsel, for a second time, requested that Mitz Kurobe provide alternate contact information so that Mitz Kurobe

could be contacted by phone for purposes of discussing issues relating to drafting and execution of the declaration. *Id.* Mitz Kurobe did not acknowledge receipt of the documents, provide the requested contact information, or otherwise communicate with counsel in response to the June 16, 2005 email message. *Id.*

On August 30, 2005, Mitz Kurobe was contacted by email for a third time. *Id.* at ¶ 6. In that message, Mitz Kurobe was reminded that his assistance and signature were needed to complete the declaration. *Id.* Mitz Kurobe was further reminded that the filing deadline for the declaration was September 17, 2005. Nevertheless, as before, Mitz Kurobe did not reply to the August 30, 2005 email or otherwise contact counsel to discuss the declaration or advise of his phone or mailing contact information. *Id.* at ¶ 7.

On September 2, 2005, a fourth email message was sent to Mitz Kurobe, requesting an immediate response regarding whether or not he could provide a declaration of prior invention. *Id.* That afternoon, Mitz Kurobe responded via email, advising that he would sign the declaration. *Id.* Accordingly, on September 14, 2005, counsel forwarded via email a draft declaration and supporting documents for approval and signature. *Id.* at ¶ 8. In that message, counsel requested that Mitz Kurobe (1) confirm receipt of the documents and (2) fax or mail the signed document to back to counsel upon review and approval. *Id.* Again, Mitz Kurobe did not respond. *Id.*

Having received no receipt confirmation by September 15, 2005, counsel sent yet another email to Mitz Kurobe requesting confirmation of his receipt of the draft declaration and reminding him of the September 17, 2005 deadline. *Id.* Mitz Kurobe never replied to the September 15, 2005 email or

otherwise contacted counsel to provide alternate contact information or discuss the declaration. *Id.*

On October 18, 2005, counsel contacted Mitz Kurobe by email for the seventh time in an attempt to secure Mitz Kurobe's cooperation in executing the declaration. Again, counsel provided (by attachment) a draft of the declaration and supporting documentation for his review and execution and further requested that he fax the signed document back to counsel as soon as possible. However, to date, Mitz Kurobe has not confirmed receipt of or replied to the October 18, 2005 email and has not faxed or mailed the completed declaration or otherwise contacted counsel to discuss the declaration or provide alternate contact information.

In view of the foregoing discussion and the Declaration of Matthew D. Durell, Esq. enclosed herewith, Applicants respectfully submit that Mitz Kurobe is not willing and/or is not available to sign the declaration of prior invention. As such, pursuant to MPEP § 715.04, the declaration of prior invention previously provided and signed by Deane Gardner, co-inventor of all rejected claims, is sufficient to prove invention of the subject matter of the above referenced claims prior to the effective date of the Uchida reference. Therefore, Applicants submit that the § 103 rejection has been overcome and respectfully request withdrawal of the rejection.

Regarding claims 8-10, 19-21, 24, 28, 31, 35, 38, 42 and 45, the Examiner has rejected each claim under 35 U.S.C. § 103 as being unpatentable over Schweickart in view of Uchida and further in view of Goodman. Reconsideration and withdrawal of this rejection is requested in view of the Declaration of Matthew D. Durell, Esq. enclosed herewith and the following discussion.

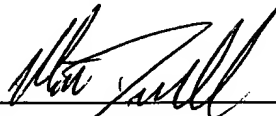
As discussed above, the Examiner acknowledges that the declarations of co-inventor Deane Gardner and Marina Portnova, Esq. submitted with Applicants' September 19, 2005 Request for Continued Examination ("RCE") constitute "sufficient [evidence] to establish a conception of the invention prior to the effective date of the Uchida reference." October 5, 2005 Action, Page 2, para. 4. Nevertheless, the Examiner has re-asserted this § 103 rejection, stating, "[t]he declaration [under 37 C.F.R. § 1.131] is defective since all inventors did not sign the declaration." October 5, 2005 Action, Page 2, para. 3. Applicants respectfully traverse.

As illustrated above, co-inventor Mitz Kurobe was contacted on at least seven different occasions for purposes of arranging for completion and signing a declaration under 37 C.F.R. § 1.131. However, Mitz Kurobe is unwilling and/or unavailable to complete and sign the declaration. As such, pursuant to MPEP § 715.04, the declaration of prior invention previously provided and signed by Deane Gardner, co-inventor of all rejected claims, is sufficient to prove invention of the subject matter of the above referenced claims prior to the effective date of the Uchida reference. Therefore, Applicants submit that the § 103 rejection has been overcome and respectfully request withdrawal of the rejection.

CONCLUSION

In view of the foregoing Remarks and the Declaration submitted herewith, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,



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